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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/320,921	05/27/1999	MICHAEL F. GUHEEN	AND1P104	5611

7590 05/02/2003

Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903

EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/320,921

Applicant(s)

GUHEEN ET AL.

Examiner

Thomas A. Dixon

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment / Arguments

1. Applicant's arguments filed 24 February 2003 have been fully considered but are not persuasive.

Applicant's arguments and referenced section of the specification, page 22, provide disclosure of a database, but no disclosure of the means to perform the method or system structure or components.

2. Regarding the 102 rejection.

The icons/displays of Ferguson et al ('092), see figure 7 and 8 which refer to the screens of figures 15 and 16 are seen to be indicia coding/pictorial representation of the components of the system claimed. The management of the components is performed through the manipulations of the document's appearance of figure 3a.

3. Regarding the 103 rejection.

In response to applicant's argument that Blower Jr. et al ('952) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Blower Jr. et al is relied on for the display of the known technology of texture shading on a computer report. Though the application of the computer is different, the report shading is a computer feature not molecular biology issue.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3629

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per Claims 1-21.

Though the claims recite method and “means” of displaying, presenting, conveying and presenting again, there is no technological apparatus which is manipulated to perform the steps and not in the technological arts, it is therefore non-statutory.

Applicant's arguments and referenced section of the specification, page 22, provide disclosure of a database, but no disclosure of the means to perform the method or system structure or components.

Claim Rejections - 35 USC § 112 6th Paragraph

6. Claim 19 is rejected over 35 U.S.C. 112 6th paragraph.

Although Applicant(s) use “means for” in the claim(s) (e.g. claim 19), it is the Examiner's position that the “means for” phrase(s) do not invoke 35 U.S.C. 112 6th

paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of "means for" from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the "means for" phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th Paragraph*.¹

Failure by Applicant(s) to address the 35 U.S.C. 112 6th paragraph issues in the manner set forth above or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6th paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claim 1-6, 8, 10-15, 17, 19 rejected under 35 U.S.C. 102(e) as being anticipated by Ferguson et al (5,819,092).

As per Claim 1.
Ferguson et al ('092) discloses:

¹ Federal Register Vol. 65, No 120, June 21, 2000.

Art Unit: 3629

- a) displaying a pictorial representation of an existing system including a plurality of components, see figures 3a, 7-13, also column 19, line 42 – Column 20, line 18;
- b) presenting information related to building the components of the existing system by indicia coding the components on the pictorial representation, see figure 3a (315,320,330);
- c) conveying information relating to managing the components of the existing system by indicia coding the components on the pictorial representation, see figure 3a (317);
- d) presenting information relating to supporting the components of the existing system by indicia coding the components on the pictorial representation, see figure 3a (340, 362).

As per Claim 2.

Ferguson et al ('092) discloses all the limitations of claim 1.

Ferguson et al ('092) further discloses:

the building, management and support information presented and conveyed relates to deliverable features in a business offering, see figure 10 (product tips and tricks, product catalog, company newsletter, corporate information)

As per Claim 3.

Ferguson et al ('092) discloses all the limitations of claim 2.

Ferguson et al ('092) further discloses:

the features are listed in terms of the components to which each service relates, see figure 10 (product advice messages, product database, newsletter portable document, corporate information database).

As per Claim 4.

Ferguson et al ('092) discloses all the limitations of claim 3.

Ferguson et al ('092) further discloses:

the features included in the business offering are indicia encoded, see figure 10 (labeled boxes).

As per Claim 5.

Ferguson et al ('092) discloses all the limitations of claim 1.

Ferguson et al ('092) further discloses:

the components are selected from the group of components including security services, network services, web services, client services, integration capabilities, data services, directory services, management services, operations services and developer services, see figure 10.

As per Claim 6.

Ferguson et al ('092) discloses all the limitations of claim 1.

Ferguson et al ('092) further discloses:

Art Unit: 3629

the components are selected from the group of components including commerce-related services, content-related services, administration related services, customer related services and education related services, see figure 10.

As per Claim 8.

Ferguson et al ('092) discloses all the limitations of claim 1.

Ferguson et al ('092) further discloses:

the existing system is a web architecture framework, see figure 11.

As per Claim 10.

Ferguson et al ('092) discloses the limitations of these claims as discussed in claim 1 above and is rejected for the same reasons.

As per Claim 11.

Ferguson et al ('092) discloses all the limitations of claim 10.

Ferguson et al ('092) in view of Blower, Jr et al ('952) disclose all the limitations as discussed in claim 2 above and is rejected for the same reasons.

As per Claim 12.

Ferguson et al ('092) discloses all the limitations of claim 11.

Ferguson et al ('092) in view of Blower, Jr et al ('952) disclose all the limitations as discussed in claim 3 above and is rejected for the same reasons.

As per Claim 13.

Ferguson et al ('092) discloses all the limitations of claim 12.

Ferguson et al ('092) in view of Blower, Jr et al ('952) disclose all the limitations as discussed in claim 4 above and is rejected for the same reasons.

As per Claim 14.

Ferguson et al ('092) discloses all the limitations of claim 10.

Ferguson et al ('092) in view of Blower, Jr et al ('952) disclose all the limitations as discussed in claim 5 above and is rejected for the same reasons.

As per Claim 15.

Ferguson et al ('092) discloses all the limitations of claim 10.

Ferguson et al ('092) in view of Blower, Jr et al ('952) disclose all the limitations as discussed in claim 6 above and is rejected for the same reasons.

As per Claim 17.

Ferguson et al ('092) discloses all the limitations of claim 10.

Ferguson et al ('092) in view of Blower, Jr et al ('952) disclose all the limitations as discussed in claim 8 above and is rejected for the same reasons.

As per Claim 19-21.

Art Unit: 3629

Ferguson et al ('092) discloses the limitations of these claims as discussed in claim 1 above and is rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7,9,16,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al (5,819,092) in view of Blower, Jr et al (6,323,952).

As per Claim 7.

Ferguson et al ('092) discloses all the limitations of claim 1.

Ferguson et al ('092) does not disclose:

wherein the indicia coding is selected from the group including texture coding, color coding and shading coding.

Blower, Jr et al ('952) teaches displaying texture, color or shading coding, see figure 2, for the benefit of distinguishing subsets of data in a summary histogram.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Ferguson et al ('092) to display texture, color or shading coding as taught by Blower, Jr et al ('952), see figure 2, for the benefit of distinguishing subsets of data in a summary histogram.

As per Claim 9.

Ferguson et al ('092) discloses all the limitations of claim 1.

Ferguson et al ('092) does not disclose:

a legend is presented.

Blower, Jr et al ('952) teaches displaying a legend, see figure 2, for the benefit of distinguishing subsets of data in a summary histogram.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Ferguson et al ('092) to display a legend as taught by Blower, Jr et al ('952), see figure 2, for the benefit of distinguishing subsets of data in a summary histogram.

As per Claim 16.

Ferguson et al ('092) discloses all the limitations of claim 10.

Art Unit: 3629

Ferguson et al ('092) in view of Blower, Jr et al ('952) disclose all the limitations as discussed in claim 7 above and is rejected for the same reasons.

As per Claim 18.

Ferguson et al ('092) discloses all the limitations of claim 10.

Ferguson et al ('092) in view of Blower, Jr et al ('952) disclose all the limitations as discussed in claim 9 above and is rejected for the same reasons.

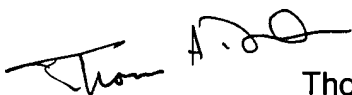
Art Unit: 3629

Conclusion

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their lawyers: that patent examiners are abysmal communicators, both orally and in writing,"² the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,³ the Examiner respectfully requests Applicant(s) *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner's positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the factual determinations and legal conclusion not expressly traversed.⁴ By addressing these issues now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the Examiner and Applicant(s) to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 746-5529 for After Final communications.



Thomas A. Dixon
Primary Examiner
Art Unit 3629

April 30, 2003

² Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

³ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

⁴ See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).